

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Greg Hupp

Serial Number: 10/672,534

Filed: September 26, 2003

For: AUTOMATIC POWER FOLDBACK FOR
AUDIO APPLICATIONS

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Group Art Unit: 2615

Examiner: Lun-See Lao

PRE-APPEAL CONFERENCE

Dear Sir:

This is a request for a pre-appeal conference in response to the Final Action dated December 24, 2008 and the Advisory dated March 12, 2009 in the above-referenced Application.

REMARKS

STATUS OF THE CLAIMS AND SPECIFICATION

- (1) The specification stands as object under 35 U.S.C. §132(a) as containing new matter.
- (2) Claim 2, 5, and 12 stands rejected under 35 U.S.C. §112, first paragraph, for assertedly failing to comply with the written description requirement.
- (3) Claims 1-4 stand rejected under 35 U.S.C. §102(e) in view of U.S. Patent No. 6,424,875 by Yoon et al. ("Yoon").
- (4) Claims 1-9, 12, and 14-16 stand rejected under 35 U.S.C. §103(a) in view of U.S. Patent Pub. No. 2001/0003166 by Gulick ("Gulick") and Yoon.

ISSUES

Applicant respectfully requests that the panel review the following errors:

- (1) objecting to the specification for containing new matter under 35 U.S.C. §132(a) because Applicant merely rephrased the text of paragraph [014];
- (2) rejecting Claims 2, 5, and 12 under 35 U.S.C. §112, first paragraph, for assertedly failing to comply with the written description requirement because Applicant was clearing in possession of the invention and did not add new matter; and

- (3) rejecting Claims 1-4 under 35 U.S.C. §102(e) in view of Yoon and Claims 1-9, 12, and 14-16 under 35 U.S.C. §103(a) in view of Gulick and Yoon because Yoon and Guilck (singularly or in combination) disclose each and every feature claimed.

ARGUMENTS

I. Specification

According to MPEP §2163.07(I), “[m]ere rephrasing of a passage does not constitute new matter.” Here, paragraph [014], as originally filed, reads as follows (with emphasis added):

[0014] Power for the circuits is provided by the power bus 116. A supervisory power circuit 134 monitors the power used by the circuit including the audio amplifier. The supervisory power circuit 134 signals the volume control circuit 136 when power sags or exceeds the specified limit. In this embodiment, the supervisor circuit monitors the voltage level. In this embodiment, the supervisor power circuit is a TPS3825 part supplied by Texas Instruments Inc.

Clearly, the underlined sentence indicates that “the supervisory power circuit 34 signals the volume control circuit 36” in two separate situations: (1) “when power sags”; and (2) “when power...exceeds the specified limit.” In other words, “the supervisory circuit 34 signals the volume control circuit when” (1) the power sags below a predetermined limit or threshold, and (2) the power exceeds the specified or predetermined limit. As a result, by amending the underlined sentence to read that “[t]he supervisory power circuit 134 signals the volume control circuit 136 when power sags below a pre-determined limit or threshold or when the power exceeds the specified or pre-determined limit,” Applicant has “merely rephrased” the passage, which does not constitute new matter. Accordingly, Applicant respectfully requests that the objection to the specification be withdrawn.

II. Rejections under 35 U.S.C. §112

According to MPEP§2163.02, “[a]n objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’” *See In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Bearing this in mind regarding Claim 2, paragraph [0011] reads as follows (with emphasis added):

[0011] The volume control circuit 36 inputs from the power supervisor circuit an indication of an over power limit state. The volume control circuit then outputs to the pre-amplifier circuit a signal that connects to the volume control of *the pre-amplifier 12*. The volume control circuit then adjusts the volume lower until indicated by the supervisory circuit 34.

Additionally, FIG. 1 of the Application, as originally filed shows reference numeral 12 as a “USB DAC.” Clearly, in paragraph [0011], the pre-amplifier is reference numeral 12, and reference numeral 12 in FIG. 1 is a “USB DAC.” Additionally, simply because the specification states that pre-amplifier circuit 12 “may include a DAC” does not mean that the pre-amplifier cannot be a DAC as the Examiner suggests. Therefore, the written description would clearly convey to one of ordinary skill in the art that “pre-amplifier is a Digital-to-Analog Converter (DAC)” as recited in Claim 2. Accordingly, Applicant respectfully requests that the rejection of Claim 2 under 35 U.S.C. §112, first paragraph, be withdrawn.

Regarding Claims 5 and 12, according to MPEP§2163.02, “[a]n objective standard for determining compliance with the written description requirement is, ‘does the description clearly allow persons of ordinary skill in the art to recognize that he or she invented what is claimed.’” *See In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Bearing this in mind, paragraph [0010] reads as follows (with emphasis added):

[0010] Power for the circuits is provided by the power bus 16. Optionally, power can be supplied by a DC power input circuit 28. In this case, a load control circuit 29 is connected to the DC power input 30, and a supply selection 32 is made if there is power available from the DC input. (However, in the preferred embodiments described in more detail below, the advantage of the present invention is primarily achieved when the DC power input is not used and power is supplied by the USB power bus.) A supervisory power circuit 34 monitors the power used by the entire circuit, or that supplied to the audio amplifier. The supervisory power circuit 34 signals the volume control circuit 36 when power sags or exceeds the specified limit. The supervisor circuit may monitor the voltage level or current used.

As stated, the “supervisory power circuit 34 monitors the power used by the entire circuit.” As a result it is clear that the USB DAC 12 of FIG. 1 would be part of the “entire circuit.” Additionally, the “supervisory power circuit 34 signals the volume control circuit 36 when power...exceeds the specified limit.” Thus, because supervisory power circuit monitors the power used by “entire circuit” (which DAC 12 belongs) and indicates when the power used “exceeds the specified limit,” it is abundantly clear that written description supports Claims 5 and 12. Accordingly, Applicant

respectfully requests that the rejections of Claims 5 and 12 under 35 U.S.C. §112, first paragraph, be withdrawn.

III. Rejections under 35 U.S.C. §102 and 103

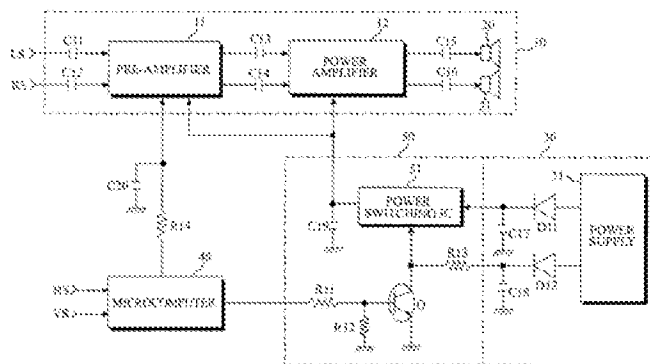
In the Office Action (at pages 5 and 7-10), the Examiner asserts that Yoon (and not Gulick) discloses the claimed arrangement of a volume control circuit. Specifically, the Examiner asserts that the microcomputer (40) of Yoon corresponds to the volume control circuit. However, this analysis simply does not comport with the disclosure of Yoon. Looking to Col. 6, ll. 3-6, Yoon specifically described the operation of microcomputer (40), stating:

Also, the volume control signal from the microcomputer 40 is applied to the pre-amplifier 11 through the resistor R14, thereby allowing the pre-amplifier 11 to adjust the volumes of the L and R channel audio signals LS and RS.

Additionally, at Col. 5, ll. 34-39, Yoon describes the operation of the asserted power supervisory circuit of power switching device (50) and power supply circuit (30), stating:

A power switching device 50 is operated under the control of the microcomputer 40 to supply the operating power from the power supply circuit 30 to the audio processor 10 in normal and standby modes and to block the operating power from the power supply circuit 30 to the audio processor 10 in suspend and power off modes.

Moreover, the construction of this circuit can be seen in FIG. 2 below:



Thus, it is clear from the description there is *no* communication between power switching device (50) and power supply circuit (30) to the microcomputer (40) related to power usage detected by the asserted power supervisory circuit of power switching device (50) and power supply circuit (30).

Microcomputer (40) merely provides volume adjustments independent of any assertedly detected power usage, so asserted volume control circuit (microcomputer 40) *cannot* “activate[] at least one of the volume control inputs when the supervisory circuit detects the power used the pre-amplifier[, DAC, or USB DAC] and audio amplifier is beyond a pre-determined limit” as claimed. (Emphasis added.) Therefore, neither Yoon nor Guilck disclose, singularly or in combination, each and every limitation of Claims 1, 5, and 12, and Applicant respectfully requests that the rejections of Claims 1-9, 12, and 14-16 be withdrawn and that Claims 1-9, 12, and 14-16 be allowed.

IV. Conclusion

Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1-9, 12, and 14-16.

Applicant does not believe that any other fees are due; however, in the event that any fees are due, the Commission is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account No. 20-0668 of Texas Instruments Incorporated.

Should the Examiner require any further clarification to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

Dated: March 16, 2009

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